

REMARKS

Claims 1-30 are pending in the application, claims 1, 11, 12 and 22 are withdrawn from consideration. Applicant's gratefully acknowledge the indication that claims 10, 16-21 and 27-30 have been allowed.

The specification has been amended to insert information relating to Government Support and an ATCC deposit. No new matter has been added by virtue of these amendments. Support for the amendments may be found in the application as filed. In particular, support for the amendment to the paragraph on page 53 may be found, for example, at page 115, lines 18-29.

Priority

The Examiner alleges that Provisional Application No. 60/062,076, filed October 15, 1997 fails to provide adequate support under 35 U.S.C. §112 for claims 2-10, 13-21, and 23-30 of the instant application. Applicants respectfully disagree and wish to point out to the Examiner that U.S.S.N. 60/062,076 contains five polypeptide sequences (SEQ ID NOs: 6-10) including SEQ ID NO: 8 which corresponds to SEQ ID NO: 22 of the instant application, SEQ ID NO: 9 which corresponds to SEQ ID NO: 24 of the instant application, SEQ ID NO: 10 which corresponds to SEQ ID NO: 21 of the instant application, and SEQ ID NO: 6 which has 96.6% identity with SEQ ID NO: 16 of the instant application. Accordingly, reconsideration is respectfully requested.

Specification

The specification was objected to for lack of an ATCC deposit number at page 53, line 28. Applicants note that the appropriate deposit information has been inserted as requested by the Examiner. Applicants have enclosed a copy of the ATCC deposit receipt reflecting the deposit information for the Examiner's convenience. The ATCC receipt is attached to this Response as Attachment A. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 2-8, 13, and 23-26 under 35 U.S.C. § 102(e)

Claims 2-8, 13, and 23-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wang et al. (U.S. Patent No. 6,518,256). The Action states that “Wang et al. teach a method of determining the presence or absence of a carcinoma by detecting the presence of a peptide that is 99.9% identical to that of SEQ ID NO: 13” (Office Action at 4). A sequence alignment provided with the Office Action shows an alignment of SEQ ID NO: 339 of Wang et al. (U.S. Patent No. 6,518,256) with SEQ ID NO: 13 of the instant application.

The rejection is respectfully traversed.

Applicants note that the Wang et al. patent (U.S. Patent No. 6,518,256) was filed on April 4, 2000 and claims priority to a date of March 18, 1998 through a series of *eight continuation-in-part* applications. The filing date of the parent application (e.g., U.S.S.N. 09/040,802) may only be used as the 35 U.S.C. §102(e) date if the parent application properly supports the subject matter used to make the rejection under 35 U.S.C. §102(e) (see MPEP § 706.02(f)(1)).

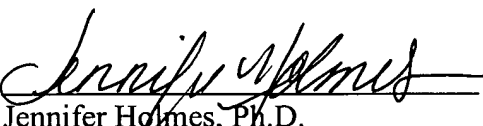
Applicants have examined U.S.S.N. 09/040,802 and were unable to find any subject matter that Applicants believe properly supports the current rejection. In particular, Applicants note that U.S.S.N. 09/040,802 does not contain any polypeptide sequences. Furthermore, of the 86 nucleotide sequences contained in U.S.S.N. 09/040,802, the longest sequence is 865 nucleotides which would encode a polypeptide of at most 288 amino acids in length. Accordingly, none of the nucleotide sequences in U.S.S.N. 09/040,802 would be long enough to encode the 641 amino acid sequence of SEQ ID NO: 339 of Wang et al. (U.S. Patent No. 6,518,256). If the Examiner wishes to maintain this rejection, Applicants request that the Examiner point out with specificity the subject matter in U.S.S.N. 09/040,802 which supports the current rejection, including, for example, SEQ ID NO: 339 from U.S. Patent No. 6,518,256. In the absence of such a showing, Applicants assert that U.S. Patent No. 6,518,256 is not a proper reference under 35 U.S.C. § 102(e) because the earliest priority date for that patent which supports the subject matter used to make this rejection will fall after Applicants’ priority dates (October 15, 1997 and May 29, 1998). Accordingly, reconsideration and withdrawal of the rejection is respectfully requested absent a showing by the Examiner to the contrary.

Applicants believe that the remarks made herein fully address all issues raised in the Office Action. Silence with regard to any of the Examiner's rejections is not an acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicant considers allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claim(s), but rather a recognition by Applicant that such previously lodged rejection is moot based on Applicant remarks and/or amendments relative to the independent claim (that Applicant considers allowable) from which the dependent claim(s) depends.

CONCLUSION

Based on the above Remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If a telephone conversation with Applicant's Agent would expedite prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 832-1000.

Respectfully submitted,

By: 
Jennifer Holmes, Ph.D.
Reg. No. 46,778
Agent for Applicants

Patent Group
FOLEY HOAG LLP
155 Seaport Blvd.
Boston, MA 02210-2600
Telephone: (617) 832-1000
Facsimile: (617) 832-7000

Dated: September 15, 2004

Customer No. 25181



American Type Culture Collection

12301 Parklawn Drive • Rockville, MD 20852 USA • Telephone: 301-231-5519 or 231-5532 • FAX: 301-816-4366

BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3
AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

Harvard Medical School
Attn: Annie Yang
240 Longwood Avenue
Boston, MA 02115

Deposited on Behalf of: Harvard Medical School

Identification Reference by Depositor:

ATCC Designation

Hup63geno (PAC)

209359

The deposit was accompanied by: ___ a scientific description _ a proposed taxonomic description indicated above.

The deposit was received October 13, 1997 by this International Depository Authority and has been accepted.

AT YOUR REQUEST: ☒ We will inform you of requests for the strain for 30 years.

The strain will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strain, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strain.

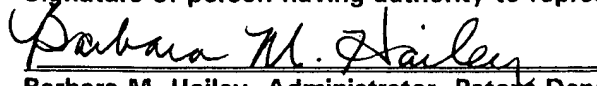
If the culture should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace it with living culture of the same.

The strain will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the culture cited above was tested October 30, 1997. On that date, the culture was viable.

International Depository Authority: American Type Culture Collection, Rockville, Md. 20852 USA

Signature of person having authority to represent ATCC:


Barbara M. Hailey, Administrator, Patent Depository

Date: October 30, 1997

cc: Dr. Matthew Vincent (Ref. Docket 19788-38.01)